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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85667426
Applicant	Monfredo, Vincent
Applied for Mark	AMERICA SECOND TO NONE
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In re Application of:

Vincent Monfredo

Law Office 105

Serial No. 85667426

Trademark Attorney: Alain Lapter

Filed: July 02, 2012



Trademark:

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Trademark Trial and Appeal Board

U.S. Patent and Trademark Office

P.O. Box 1451

Alexandria, VA 22313-1451

**BRIEF FOR APPELLANT**

***INTRODUCTION***

Applicant hereby appeals from the Examiner's refusal to register the above-identified mark dated November 22, 2013 and respectfully requests the Trademark Trial and Appeal Board to reverse the Examiner's decision.

**APPLICANT'S TRADEMARK**

Applicant seeks registration on the Principal Register of its mark AMERICA SECOND TO NONE (and design).



***PRIOR REGISTRATIONS CITED BY THE EXAMINER***

U.S. Registration No. 3773474 for SECOND II NONE

**SECOND II NONE**

## ***THE REJECTION***

The Examiner refused registration of Appellant's mark contending that the mark as applied to the goods so resembles the above cited registrations as to be likely to cause confusion, or to cause mistake, or to deceive.

## ***ARGUMENT***

### *No Prohibition on Sharing a Common Term*

There is no explicit rule that likelihood of confusion *automatically* applies where a junior user's mark contains in part the whole of another mark. See, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to incorporate

the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). *See Monsanto Co. v. CIBA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark LEAN CUSINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, Applicant registered VARGA GIRL for calendars and was refused registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. the higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the entire mark was reviewed in its entirety, there was no likelihood of confusion. Here, the fact that the marks share the word "second" and "none" is not enough to support a finding of likelihood of confusion.

### *Design Portion of Registrant's Marks Improperly Dismissed*

Consisting of Both Words and Designs) for the proposition that "When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services. Therefore, the word portion is normally

accorded greater weight in determining the likelihood of confusion.”

However, § 1207.01(c)(ii) explicitly states, “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” Moreover, it is further emphasized in this section that “the fundamental rule in this situation is that the marks must be considered in their entireties.” TMEP § 1207.01(c)(ii).

In this case, it is clear that the Examiner could have only arrived at the 2(d) refusal by dissecting the marks and then comparing the words without taking into the account the distinctive non-word elements present.

### *Marks Differ in Sight, Sound, and Commercial Impression*

#### *a. Marks Differ in Sight*

Examiner argues because the marks incorporate the wording SECOND TO NONE or the lettering II as a substitute for the word TO, they will appear the same to consumers and present the same commercial impression. However, where there is an addition of a distinctive element, as in a term or a design, or there is a significantly different display of the same terms, there is little likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). Likelihood of confusion is minimized where a design is used as part of a mark. *Harlem Wizards*, 952 F. Supp. At 1096 (citing McCarthy at §23:15[51]).

Here, the marks differ substantially in sight as the Applicant’s mark incorporates a distinctive design element of an eagle. Furthermore, the Applicant’s mark includes the term “America” and “to,”

both of which are absent from the Registrant's mark. As the marks vary significantly in sight, there is little likelihood of confusion.

*b. Marks Differ in Sound*

When not improperly dissected into component parts, the marks are pronounced in a substantially different manner. Registrant's mark is pronounced with four syllables. In contrast, Applicant's mark is pronounced with eight syllables.

However, even if this was not the case, where two marks are phonetically similar, no likelihood of confusion exists if other differentiating factors can be established. See *National Distillers & Chemical Corporation v. William Grant and Sons, Inc.*, 505 F.2d 719 (finding that DUVET and DUET did not raise likelihood of confusion where other differentiating factors existed such as the term "duet" was a common word whereas "duvet" was not). As stated above, the visual differences between Applicant's mark and the Registrant's mark provide one of many differentiating factors that do not support a claim of likelihood of confusion.

*3. Marks Differ in Commercial Impression*

Besides the differences in sight and sound, the marks differ in commercial impression. Registrant's SECOND II NONE brings to mind that their clothing, or perhaps the wearer, has no peer and is the best available. Registrant's mark invokes no notion of geography or place. The commercial impression of the Registrant's mark is one that simply conveys that the goods and the brand is of the

best quality available.

In contrast, the commercial impression of Applicant's mark makes no claim that the goods or the brand is without peer. Instead, the connotations of the Applicant's mark are strictly patriotic.

Examiner argues "the term AMERICA is geographically descriptive and therefore does not carry as much weight as an identifier of source." However, dismissing the import of that term ignores the overall impression of the mark. With a large illustration of an eagle combined with the term "America" it's very clear that the mark is conveying, unambiguously, that America is the greatest country in the world. As such, the commercial impression of the Applicant's mark is entirely distinct and non-overlapping with the very general commercial impression of "best-in-class" presented by the Registrant's mark. As such there is little likelihood of confusion.

### ***CONCLUSION***

For the reasons set forth hereinabove, Appellant submits that there is no likelihood of confusion, mistake or deception between Appellant's mark and the prior cited registration. Accordingly, Appellant's mark is entitled to registration.

The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration.

Respectfully submitted:

A handwritten signature in blue ink, consisting of a stylized 'Z' followed by a flourish.



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